

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application.

Claims 1, 2, 5-12, and 15-20 are pending.

5 **Claims 1, 2, 5-12, and 15-20** stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,529,522 issued to Ito et al. (hereinafter, “*Ito*”) in view of U.S. Patent No. 5,602,854 issued to Luse et al. (hereinafter, “*Luse*”). Applicant respectfully traverses these rejections for at least the reasons provided herein.

10 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) There must be a reasonable expectation of success; (3) The prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on appellants’ disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

20 If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See, e.g., In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

25 (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device

30 required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the “suggested combination

of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” 270 F.2d at 813, 123 USPQ at 352.).

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Regarding *Ito*:

Ito discloses techniques by which a digital camera having a wireless communication capability for use with a printer, can further communicate with another device (such as a personal computer and/or scanner) to which the printer
10 is also connected to through wired communication links. Here, the wireless link and the wired links have different communication protocols, and the printer is capable of supporting both protocols. *Ito* teaches how such a printer can be operated so data received from the camera over the printer’s wireless link can then be converted and forwarded through the printer’s wired link (i.e., IEEE-
15 1394).

To accomplish this conversion, *Ito* has the camera provide “function information” about itself to the printer. The printer then converts this function information into a format suitable for the wired IEEE-1394 link. This converted function information is then stored by the printer into a specific area of an IEEE-
20 1394 interface ROM within the printer. As a result, the IEEE-1394 interface ROM of the printer will now have one area that identifies the printer as a printer and another area that essentially further identifies the printer as also being a camera. Subsequently, when the IEEE-1394 interface/link (i.e., bus) is intentionally reset, the IEEE-1394 bus will read both areas of the printer’s IEEE-
25 1394 interface ROM and thereafter recognize the printer’s ID as being a “compound device” having the functionality of the printer and the digital camera. See, for example, column 21, lines 20-47 as originally cited in the Office Action.

Independent Claims 1, 10, 11, and 20 and related dependent claims specify that the printing device control information that is maintained in a wireless communication device includes network configuration information that is associated with a printing device and a network that is operatively
5 coupled to the printing device and that the network configuration information includes a unique network device address of the printing device for use in the network.

The Office Action recognizes that *Ito* neither discloses nor suggests that its digital camera maintains and selectively transmits to the printer any network
10 configuration information let alone that which includes a unique network device address of the printing device for use in the network.

It is clear that *Ito's* digital camera cannot operate through the wireless link as an IEEE-1394 device because it uses a different protocol for wireless communication. Hence, the digital camera knows nothing about the IEEE-
15 1394 bus or any other potential network of which the printer may be part. Further, *Ito's* digital camera does not provide any information about the printer to the printer. Instead the digital camera simply provides functional information about itself to the printer. Also, *Ito's* digital camera is fundamentally unable to provide the printer with network configuration
20 information that includes a unique network device address of the printer for use in the IEEE-1394 network, because an IEEE-1394 bus automatically assigns an ID to each connected device during configuration. Thus, no IEEE-1394 device, including *Ito's* printer, has any need or use for network configuration information that includes a unique network device address.

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Regarding Luse:

Luse is now presented in the Final Office Action in an attempt to add the missing pieces so clearly absent in *Ito*.

Luse discloses a wireless network in which a transceiver is connected to
5 each computer and peripheral device in need of communication. When
transmitting, a (transmitting) transceiver re-formats an outgoing message in
accordance with a specific wireless protocol (an Idle Sense Communication
protocol) and then sends the message over a wireless link to another (receiving)
transceiver. Per *Luse's* teachings, the Idle Sense Communication protocol allows
10 the transceivers to know if other devices are currently communicating, which
devices are present and communicating, and to selectively address the various
devices that present (see, e.g., *Luse's* Abstract). This requires that each
transceiver have a unique address or utilize a unique address of the device being
served (column 5, lines 26-30). *Luse* further specifies that "The unique address
15 can be one selected by the operator or system designer or one which is
permanently assigned at the factory as an IEEE address." (column 5, lines 30-34).

The method of **Independent Claim 1** states that "the network
configuration information includes a unique network device address of the
printing device for use in the network" and recites the act of "selectively
20 transmitting the printing device control information to the printing device over
a wireless communication interface, and wherein the wireless communication
interface is not part of the network". (emphasis added)

The method of **Independent Claim 10** states that "the network
configuration information includes a unique network device address of the
25 printing device for use in the network" and recites the act of "selectively
transmitting the printing device control information to the printing device over

a wireless communication interface that is not part of the network". (emphasis added)

Independent Claim 11 states "the network configuration information includes a unique network device address of the printing device for use in the network" and includes "a communication interface operatively coupled to the logic and configurable to selectively transmit a wireless signal having at least a portion of the printing device control information therein, and wherein the communication interface is not part of the network". (emphasis added)

Independent Claim 20 states that "the network configuration information includes a unique network device address of the printing device for use in the network" and includes "a communication interface operatively coupled to the logic and configurable to selectively transmit a wireless signal having at least a portion of the printing device control information therein, and wherein the communication interface is not part of the network". (emphasis added)

These method and apparatus claims are clearly different from *Luse*, which discloses a single communication network (i.e., the wireless network) in which unique addresses have been pre-assigned and are later gathered and used to direct messages. *Luse* fails to disclose or suggest maintaining and sending network configuration information that includes a unique network device address of a printing device for use in a network and selectively transmitting the printing device control information to the printing device over a wireless communication interface that is not part of the network.

Instead, *Luse* simply reiterates what is very well known, i.e., that to send a message to someone you need to know and include their address in your communication.

As illustrated above, the present invention is different in that the recited methods and arrangements allow a printing device to be configured with information that includes a much needed network device address for use in a network. The methods and arrangements recited in claims enable this
5 configuration through a wireless communication interface that is not part of the network.

Conclusion:

As presented by the examples above, the cited references clearly fail to
10 teach or suggest all the claim limitations. Furthermore, there does not appear to be any, let alone some, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, especially since there is no reasonable expectation of success given that Luse's printer
15 needs a pre-assigned address and Ito's printer does not.

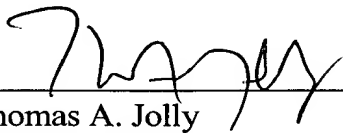
Clearly, the teaching or suggestion to make the claimed combination and the reasonable expectation of success cannot be found in the prior art, and appear to be based only on the present application. Moreover, the proposed modification or combination of the prior art would change the principle of
20 operation of the prior art inventions

Hence, a *prima facie* case of obviousness has not been established.

The pending claims are each clearly patentable over the cited art and as such are in condition for prompt allowance. Applicant respectfully requests reconsideration and prompt issuance of the subject application.

Respectfully Submitted,

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